

REMARKS***Summary of the Amendment***

Upon entry of the above amendment, claim 59 will have been amended. Accordingly, claims 28 - 55 and 57 - 84 currently remain pending.

Summary of the Official Action

In the instant Office Action, the Examiner has indicated that claims 55, 57, 58, 70 - 82, and 84 are allowed and that claim 59 and 60 contain allowable subject matter and would be allowable if presented in an independent form that include all of the features of its base claim and any intervening claim. The Examiner has rejected claims 28 - 54, 61 - 69, and 83 over the art of record. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Acknowledgment of Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's indication that claims 55, 57, 58, 70 - 82, and 84 are allowed. Applicants further acknowledge that claims 59 and 60 contain allowable subject matter and would be allowable if presented in independent form to include all of the features of its base claim and any intervening claims. Accordingly, by the present amendment, claim 84 has been presented in independent and allowable form.

By the present amendment, claim 59 has been presented in independent and allowable

form. Moreover, as claim 59 is now allowable, Applicants submit that the claim 60, which depends from allowable claim 59, is likewise allowable. Confirmation of the same by the Examiner in the next official communication is requested.

Entry of Amendment is Proper

Applicants note that, as entry of the instant amendment does not raise any question of new matter nor any new issues for consideration by the Examiner, entry of the amendment is proper. In particular, as claim 59 has merely been presented in independent and allowable form in reply to the Examiner's indication of allowable subject matter, entry of the present amendment is requested.

Traversal of Rejection Under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 28 - 54, 61 - 69, and 83 under 35 U.S.C. § 103(a) as being unpatentable over HALMSCHLAGER et al. (European Patent Application No. 0 933 473) in view of BUBIK et al. (U.S. Patent No. 4,417,950) [hereinafter "BUBIK"], KANKAANPAA (U.S. Patent No. 4,406,739) and ARMSTRONG et al. (U.S. Patent No. 4,425,187) [hereinafter "ARMSTRONG"]. The Examiner asserts that HALMSCHLAGER shows the recited features with the exception of guiding the wires at an upward angle with an upper vortex of the second deflection roll being higher than a lower vertex of the first deflection roll. However, the Examiner asserts that, as BUBIK shows an upward guiding of the wires, it would have been obvious to modify HALMSCHLAGER to utilize the same

arrangement. The Examiner has also indicated that KANKAANPAA and ARMSTRONG support the asserted modification. Applicants traverse the Examiner's assertions.

As Applicants have previously noted, HALMSCHLAGER discloses a twin wire former, but fails to provide any teaching or suggestion of a second deflection device located after the separating device that is arranged to deflect the second endless wire carrying the forming web over an upper vertex of the second deflection device, as recited in claim 28. Instead, HALMSCHLAGER discloses a suction pick-up roll to remove the web from passing wire 12 (see Figure 5). However, in contrast to the instant invention, Applicants note that HALMSCHLAGER fails teach or suggest that, after the second deflection device, the second wire is arranged to run at a downward angle, as recited in at least independent claim 28.

In contrast to the construction of HALMSCHLAGER's twin wire former, BUBIK discloses a structurally distinctive former in which an upper wire is pivotably mounted to open and close contact with the lower wire. While Figure 5 of BUBIK arguably shows separated and upwardly guided wires guided over a deflection roll, Applicants note that BUBIK fails to provide any teaching or suggestion of any benefits that are achieved through this arrangement, nor is there any teaching or suggestion of any problem in the art this is addressed by the particular arrangement.

In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the art would

have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985) To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

As noted above, HALMSCHLAGER and BUBIK are directed to different former arrangements that operate in different manners. Moreover, neither document teaches or suggests modifying the structure or operation of HALMSCHLAGER in the manner asserted by the Examiner.

In this regard, while Applicants acknowledge that BUBIK shows upwardly guided wires, Applicants note that BUBIK fails to provide any teaching that this specific arrangement, in and of itself, provides advantageous results and/or that this arrangement would provide similar benefits in other formers, including formers that are structurally and operationally different than that of BUBIK. In other words, Applicants submit that the mere fact that BUBIK shows an arrangement of elements recited in the pending claims is not a reason that one ordinarily skilled in the art would modify the arrangement of HALMSCHLAGER in the manner asserted by the Examiner.

In addition to showing the recited arrangement of elements, the applied art must also

provide the necessary motivation or rationale for combining the art of record in the manner asserted by the Examiner. Specifically, Applicants note that BUBIK does not disclose or suggest any advantages achieved as a result of the upwardly guided wires that would provide corresponding benefits in a former such as HALMSCHLAGER.

Because the art of record fails to provide any reasonable explanation why one ordinarily skilled in the art would utilize such an arrangement, and/or fails to disclose or suggest the problems that such an arrangement would address, Applicants submit that the art of record fails to provide the requisite motivation or rationale as to *why* one ordinarily skilled in the art would modify HALMSCHLAGER in the manner asserted by the Examiner. That is, Applicants submit that because the Examiner has not set forth an articulable reason found in the art of record for modifying HALMSCHLAGER in the manner asserted by the Examiner, the instant rejection has no basis in the art of record, such that the rejection is improper and should be withdrawn.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates*,

Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Applicants submit that the only reason to combine the teachings of the applied references in the manner proposed by the Examiner is the result of a review of Applicants' disclosure and the application impermissible hindsight.

In particular, Applicants submit that, because the formers that are the subjects of the applied art are structurally distinct from each other, the art of record fails to provide any showing that the use of the BUBIK arrangement, or any portion thereof, would have any utility at all in HALMSCHLAGER. In this regard, Applicants note that initial dewatering is performed differently in each document, i.e., BUBIK provides significant dewatering prior to pressing the material suspension between two wire, whereas HALMSCHLAGER's initial dewatering is while the suspension is between the two wires. Because of these and other differences in structure and operation of the subject formers of HALMSCHLAGER and BUBIK, Applicants submit that it is not apparent that, if modified in the manner asserted by the Examiner, HALMSCHLAGER would continue to operate in its intended manner, especially since HALMSCHLAGER requires a forming shoe (not utilized by BUBIK) as well as forming strips (not utilized by BUBIK) and suction after the first deflection device,

whereas BUBIK requires only a catch basin.

Thus, Applicants submit that it is apparent that the asserted combination would prevent HALMSCHLAGER from operating in its intended manner, or so materially change BUBIK, such that the modification would be based, not upon the teaching of BUBIK, but upon Applicants' disclosure and the application of impermissible hindsight.

Moreover, Applicants note that, while disclosing formers that are structurally distinct from both HALMSCHLAGER and BUBIK, neither KANKAANPAA and ARMSTRONG teach or suggest the necessary motivation or rationale to modify HALMSCHLAGER in the manner asserted by the Examiner. In this regard, even assuming, *arguendo*, that the benefits of the arrangements of BUBIK, ARMSTRONG, and/or KANKAANPAA were expressly disclosed (which Applicants submit they are not), Applicants submit that the art of record fails to provide any teaching or suggestion that HALMSCHLAGER would enjoy a corresponding benefit through modification in the manner asserted by the Examiner, and certainly fails to show that such a modification would have been obvious.

Accordingly, Applicants submit that the asserted rejection of independent claim 28 is improper and should be withdrawn.

Further, Applicants submit that claims 29 - 54, 61 - 69, and 83 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicants

submit that no proper combination of HALMSCHLAGER in view of BUBIK, KANKAANPAA and ARMSTRONG teaches or suggests the combination of features recited in these dependent claims.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of claims 28 - 54, 61 - 69, and 83 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

The Commissioner is authorized to charge to Deposit Account No. 19 - 0089 any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, in order to maintain pendency of this application.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants'

invention, as recited in each of claims 28 - 55 and 57 - 84. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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